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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,085	10/29/2003	Naum Sapozhnikov		5942

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EXAMINER

MARCANTONI, PAUL D

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 10/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/696,085

Applicant(s)

SAPOZHNIKOV, NAUM

Examiner

Paul Marcantoni

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Applicant's arguments filed 7/26/05 have been fully considered but they are not persuasive. The applicants amendment necessitated the following new grounds of rejection.

Citation of Prior Art Relevant to Invention but Not used in Rejection:

Chervenka Jr et al., Yoshikane et al. and Singh et al. (abstract only) have been cited of interest as relevant art and could also have been used in a rejection of applicants claims as all teach airport concrete. These references can be found on the provided PTO-892.

Obviousness Type Double Patenting:

Applicants' presentation of new claims to the airport concrete pavement (process claims were non-elected in previous office action) necessitated this grounds of rejection. Further, since the inventor is the same, applicants were already aware of the filing of this patent application which claims the same invention or at least an invention that falls into the realm of obviousness for double patenting purposes.

Claims 14-25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over all claims of copending Application No. 10/945,693 (Sapozhnikov-which is US Patent Appl. Pub 2005/0061208 A1) Although the conflicting claims are not identical, they are not patentably distinct from each other because both teach the same invention in that both claim an airport concrete pavement of the same expected properties. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

35 USC 103:

Claims 14-25 are rejected under under 35 U.S.C. 103(a) as obvious over Lees et al. (Re 30,047 or US Patent No. 4,105,458), Sawyer '674, or Lang '956,

The above cited references teach airport concrete that is made in a conventional manner containing cement and aggregate which is mandatory ingredients for concrete thus anticipating the instant invention. Further, even if not anticipated, control of concrete thickness would have been an obvious design choice within the control of one of ordinary skill in the art. More so, the applicants extensive claiming of functional language would appear to be properties already found in concrete used for airport runways or taxiways and thus is not seen as a patentable distinction over the prior art.

35 USC 112

Claims 14-25 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The applicants' claim concrete for airport runways yet they do not particularly point out and distinctly claim their invention. What is the *specific composition* of the concrete which gives these properties? What exactly is the claimed invention? It is unclear what applicants are trying to claim based upon the vague functional language presented in claims 1-5.

Also, the applicants are reminded that the following case law also applies. "An article characterized by physical properties alone and no specific composition is vague and indefinite." Ex parte Slob, 157 USPQ 172. In other words, setting forth functional properties without setting forth the specific identity or composition of the concrete pavement is indefinite. It is not clear if it is even Portland cement concrete or some other type of cement or if it includes asphalt, aggregate (what type), etc.

Response:

Claims 14-25 are rejected under 35 U.S.C. 103(a) over Lees et al. (Re 30,047 or US Patent No. 4,105,458), Sawyer '674, or Lang '956. All references no longer in the rejection have been withdrawn.

The applicants argue **Lees (RE 30,047 or US 4,105,458)** do not teach a complete utilization of flexural strength of normal concrete. In rebuttal, it is the examiner's position that Lees et al. '458 teach a blend of at least two aggregate material disposed in a binder matrix such as Portland cement that can be used for airport runways (col.1, line 62). Lees et al. thus clearly teach a concrete pavement for airport runways. Further, it is the examiner's position that control of concrete thickness

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would have been an obvious design choice for one of ordinary skill in the art. It is not seen why one of ordinary skill in the art could not easily modify the concrete thickness of the airport runway. Applicants should also note that they do not particularly point out and distinctly claim their concrete pavement either. It is not clear if it is Portland cement, what the aggregates are for this concrete and how much of each component is in the pavement ^{to} ~~not~~ give it the alleged unexpected flexural strengths over the alleged conventional concrete.

The applicants argue that **Sawyer '674** which does teach the use of his concrete for airport runways and thus meets applicants' preamble. Applicants argue that Sawyer's concrete involves a special mix of concrete and not ordinary concrete. The examiner is not convinced Sawyer's concrete is anything special since he claims use of Portland cement as binder. Further, applicants never even define that their own concrete is Portland cement concrete nor do they claim the specific aggregate and the amounts of Portland cement and aggregate critical to obtain the claimed strength values. Again, it is the examiner's position that control of concrete thickness would have been an obvious design choice for one of ordinary skill in the art.

The applicants also argue that **Lang** is directed to highway pavement it is assumed versus the airport concrete pavement of their instant invention. The applicants did not mention that Lang is not limited to only highway pavements but includes airport pavements as well (see lines 5-9 of col.1). The applicants further argue that Lang has no relationship to the "process" for designing normal concrete to provide saving of concrete by using more efficiently the flexural strength of concrete. In rebuttal, the

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claimed invention is not a process but a product or article because concrete pavement is being claimed. Also, it is the examiner's position that control of concrete thickness would have been an obvious design choice for one of ordinary skill in the art.

It is the examiner's position that the applicants set forth the desired physical properties of their concrete pavement without setting forth actually what the specific concrete composition is for their instant invention. It is unclear if it is Portland cement, aggregate (what type(s)), and how much of each, etc. that allow for obtaining a specific flexural strength value. "An article characterized by physical properties alone and no specific composition is vague and indefinite." Ex parte Slob, 157 USPQ 172. In other words, setting forth functional properties without setting forth the specific identity or composition of the concrete pavement is indefinite. It is not clear if it is even Portland cement concrete or some other type of cement or if it includes asphalt, aggregate (what type), etc. Thus, applicants cannot claim physical properties over the prior art when they themselves do not even set forth a specific composition of their own in the claims.

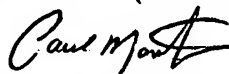
For the foregoing reasons and the fact that the rejections above were necessitated by amendment, the finality of this office action is now proper. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Marcantoni
Primary Examiner
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